

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

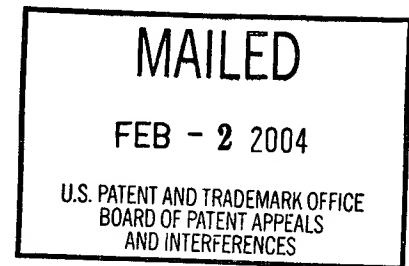
Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DOUGLAS T. ROSS,
HANSJÖRG SAUER,
GREGORY S. HAMILTON, and
JOSEPH P. STEINER

Appeal No. 2003-0916
Application No. 09/134,419



ON REMAND TO THE EXAMINER

Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not ready for a
disposition on appeal. Accordingly, we remand the application to the examiner for
further proceedings not inconsistent with the views expressed herein.

The Record

In their Appeal Brief, applicants presume that Teri et al.¹ constitutes evidence of record. See Paper No. 19, pages 7 and 10. That, however, is not clear.

On September 13, 2001, the PTO received applicants' Notice of appeal from the examiner's decision finally rejecting claims 1 through 4, 6, 8 through 11, and 21 through 37, which are all the claims pending in this application. In a separate paper received on the same date, captioned "Response and Amendment," applicants proffered an amendment to claim 1 and submitted remarks (Paper No. 15). Applicants argued that the examiner should "reconsider and withdraw" all rejections of their claims in light of the amendment and remarks (id. at page 14). Further, applicants enclosed a copy of the Teri reference with their "Response and Amendment" and referred to Teri in their remarks (id. at pages 7 and 13).

In an Advisory Action mailed October 19, 2001 (Paper No. 17), the examiner denied entry of applicants' proffered amendment. The examiner indicated that applicants' remarks have been considered but do not place the application in condition for allowance for "the reasons of record." The examiner did not specifically comment on the Teri reference, or expressly state whether that reference was admitted and made of record. See 37 CFR § 1.195 ("Affidavits, declarations, or exhibits submitted

¹ Teri et al. (Teri), "Imipramine in the Treatment of Depressed Alzheimer's Patients: Impact on Cognition," The Journals of Gerontology, Vol. 46, No. 6, pp. 372-377 (November 1991)

after the case has been appealed will not be admitted without a showing of good and sufficient reasons why there were not earlier presented").

On return of this application to the Examining Corps, we recommend that the examiner (1) take into account the provisions of 37 CFR § 1.195, and (2) expressly state whether the Teri reference has been admitted and made of record. Based on our review of the file, it would not appear that applicants presented "a showing of good and sufficient reasons" why that reference, and the arguments based thereon, were not earlier presented. Again, applicants refer to Teri in their Appeal Brief, and it is important that we know whether this reference is, or is not, of record.

The Issue of Structural Obviousness

Based on our review of the record, it would appear that the examiner misapprehends the scope and content of Hamilton et al.² As best we can judge, the examiner takes the position that compounds recited in applicants' claims are identical to compounds disclosed and claimed by Hamilton. For example, in setting forth a rejection under the judicially created doctrine of obviousness-type double patenting, the examiner states that "the claims of '378 are drawn to treating or effecting neuronal activity via stimulation of damaged neurons, promotion of neuronal regulation and treatment of a neurological disorder using the same compounds set forth in the instant

² U.S. Patent No. 5,786,378 issued to Hamilton et al. (Hamilton) on July 28, 1998

application" (Paper No. 20, page 4, lines 4 through 7; emphasis added). Likewise, in discussing a rejection under 35 U.S.C. § 103(a), the examiner states that "[a]ppellant [sic] does not dispute that the compounds of the invention have been set forth in the prior art" (id., page 10, lines 1 and 2; emphasis added). The examiner does not, however, point to any passage or passages in Hamilton disclosing or claiming the same compounds recited in applicants' claims.

Claim 1 on appeal requires administering a nitrogen-containing heterocyclic compound having two or more heteroatoms, wherein said compound, inter alia, "is additionally substituted with a [sic] ester or amide substituent attached to the heterocyclic ring." On this record, the examiner has not established that the compounds disclosed or claimed by Hamilton meet the foregoing claim requirement. Based on our review of Hamilton, it would not appear that this reference discloses a nitrogen-containing heterocyclic compound wherein said compound is additionally substituted with an amide substituent attached to the heterocyclic ring. It cannot be gainsaid that Hamilton discloses and claims nitrogen-containing heterocyclic compounds additionally substituted with a thioester substituent attached to the heterocyclic ring. Note particularly Hamilton's compounds where variable Z is sulfur. In the vocabulary of organic chemistry, however, esters and thioesters are different. Again, the examiner does not point to any passage or passages in Hamilton disclosing or claiming a nitrogen-containing heterocyclic compound having two or more heteroatoms "wherein said compound is additionally substituted with [an] ester . . .

substituent attached to the heterocyclic ring" (emphasis added). To the extent that applicants would attribute a meaning to the term "ester" different from or broader than the meaning conventionally used by persons skilled in the art, neither the examiner nor applicants have made clear on this record just what that different or broader meaning is. In any event, it is simply not apparent, in the absence of further explanation, where Hamilton discloses or claims the same compounds recited in appealed claim 1.

We also note that the compounds illustrated by formula in claim 22 are distinguishable from the compounds disclosed and claimed by Hamilton. In claim 22, variable Z is O, NH, NR₁, or a bond; whereas Hamilton discloses that variable Z is S, CH₂, CHR₁, or C(R₁)₂.

On return of this application to the Examining Corps, we recommend that the examiner review the Hamilton patent in its entirety and compare its teachings with the method claims on appeal. If the examiner adheres to the position that compounds recited in applicants' claims are identical to compounds disclosed and claimed by Hamilton, we recommend that the examiner point to specific passages in Hamilton establishing that this is so. In this regard, the examiner should consider the requirement in claim 1 that "said compound is additionally substituted with [an] ester or amide substituent attached to the heterocyclic ring."

We also invite attention to In re Grabiak, 769 F.2d 729, 732, 226 USPQ 870, 872 (Fed. Cir. 1985), where the court reversed a rejection under 35 U.S.C. § 103 because

The PTO cited no pertinent reference showing or suggesting to one of ordinary skill in the art the change of a thioester for an ester group. In the absence of such reference, there is inadequate support for the PTO's position that this modification would prima facie have been obvious.

Claim 6

On its face, dependent claim 6 would not appear to comply with the provisions of 35 U.S.C. § 112, fourth paragraph. This follows because independent claim 1 is restricted to a method for treating a nerve-related vision disorder or treating memory impairment in a mammal in need thereof. In other words, the "mammal in need thereof" in claim 1 suffers from a specified disorder. On the contrary, the method of claim 6 "is for improving naturally-occurring vision in an animal, in the absence of any ophthalmologic disorder, disease, or injury." On these facts, it would not appear that dependent claim 6 specifies a further limitation of the subject matter claimed in claim 1; or that claim 6 may be construed to incorporate by reference all the limitations of claim 1. See 35 U.S.C. § 112, fourth paragraph.

On return of this application to the Examining Corps, we recommend that the examiner review dependent claim 6 for compliance with the provisions of 35 U.S.C. § 112, fourth paragraph.

In conclusion, for the reasons set forth in the body of this opinion, we find that this case is not ready for a disposition on appeal. Accordingly, we remand this application to the examiner for further proceedings not inconsistent with the views expressed herein.

REMANDED

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Page 8

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